

REMARKS

Claims 1-16 are pending in this application.

Claim Amendments

Claims 1, 3, 5, 8, 9, 12, 13, 15, and 16 are being amended to further clarify the claim language. These amendments are not made for reasons related to patentability.

§102(b) Rejection of Claims 1-16 over Gilbert et al.

The Examiner rejected claims 1-16 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,805,861 to Gilbert et al. ("*Gilbert et al.*"). Applicants respectfully traverse the rejection for the following reasons.

In order to properly anticipate Applicants' claimed invention under 35 U.S.C. § 102, each and every element of the claim at issue must be found in the reference, either expressly described or under principles of inherency. Furthermore, "the elements must be arranged as required by the claim." M.P.E.P. § 2131. See also *Richardson v. Suzuki Motor Co., Ltd.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913 (Fed. Cir. 1989). The reference cannot require "picking, choosing, and combining various disclosures not directly related to each other by the teachings." *In re Arkley*, 455 F.2d 586, 587-88, 172 USPQ 524 (CCPA 1978).

However, the Examiner is making exactly such a prohibited piecemeal rejection. For example, to reject claim 1 the Examiner alleges, inter alia:

- (1) that the “plurality of test vectors” in the claim element “a logic verification unit configured to perform a logic verification by inputting a plurality of test vectors...” read on the “design change flag” (96) in Figure 6 of *Gilbert* (Office Action, pg. 2);
- (2) that the “test vectors” in the claim element “a profile information generating unit configured to store information about a plurality of logic cones ... to be activated by the test vectors...” read on the language “select cone of logic from both design versions” (48) in Figure 4 of *Gilbert et al.* (Office Action, pg. 3); and
- (3) that the “test vectors” in the claim element “a test vector classifying unit configured to classify the test vectors...” read on the “names” (54-60) in Figure 4 of *Gilbert et al.* (Office Action, pg. 3).

The Examiner is picking and choosing various different features disclosed in *Gilbert et al.* that are not arranged as in claim 1, and applying each of these disclosures to individual portions of claim 1. For example, the Examiner takes each occurrence of the term “test vectors,” considered in isolation in claim 1, and compares it to a particular disclosure in *Gilbert et al.*, also considered in isolation. However, the Examiner fails to consider the relationship between the multiple claim elements that use the “test vectors,” and fails to realize that *Gilbert et al.* does not disclose the same relationship.

The expression "test vectors" used throughout claim 1 clearly refers to all or some of the same "test vectors" defined in regard to the "logic verification unit." However, the multiple disclosures in *Gilbert et al.* that the Examiner alleges to be "test vectors" are not arranged as required by the claim.

For example, consider the claimed requirement of a "plurality of logic cones in the circuit description to be activated by the test vectors." *Gilbert et al.* fails to teach that the "design change flag" 96 "activates" the "logic cones" 48, which the Examiner alleges correspond to the claimed logic cones. Instead, "At Step 48, CGC processing selects a common cone of logic from both design versions by means of locating identical source and destination net names" (Col. 10, lines 2-5). "At Test Step 50, the new cone of logic is compared to the corresponding old cone of logic. If the cones are identical in structure, then Yes path 52 is taken to Step 54" (Col. 10, lines 16-18). The "design change flag" 96 is only used after the CGC processing "selects a common cone of logic from both design versions" (Col. 12, lines 4-16; Col. 10, lines 2-5). For at least this reason, the "design change flag" 96 does not "activate" the "logic cones" 48. Additionally, the "design change flag" 96 and "names" 54-60 of *Gilbert et al.*, both alleged by the Examiner to correspond to the claimed test vectors, are different entities, and neither is a "test vector."

Thus, the Examiner's § 102(b) rejection of claim 1 requires picking, choosing, and combining various disclosures in *Gilbert et al.* that are not "arranged as required by the claim." A similar type of piecemeal rejection is being used to reject independent claims 3 and 8. Thus, *Gilbert et al.* does not anticipate independent claims 1, 3, and 8, and claims 2, 4-7, and 9-16 dependent therefrom.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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